

In re application of:	SIFFERT, W.	Group:	1655
Application No.:	09/836,697	Examiner:	Carla Myers
Filed:	04/16/2001		
For:	THE USE OF A GENETIC MODIFICATION IN THE GENE FOR HUMAN G PROTEIN $\beta$ 3 SUBUNIT FOR THE DIAGNOSIS OF DISEASES		

### **REMARKS**

Claims have been amended to further define the present invention. Claims 1 – 36 have been cancelled. Claim 37 is now directed to disorders associated with a substitution of cytosine by thymine at position 825 in SEQ ID NO: 1. Support for this amendment can be found throughout the specification. No new matter has been added by virtue of the amendments to claim 37.

Claims 13 – 19, 21 – 28, 32 – 35 and 37 rejected under 35 U.S.C. §112 first paragraph.

Applicant respectfully disagrees and requests that this rejection be withdrawn for the following reasons.

Applicant respectfully submits that claim 37, as amended, is fully enabled by the present specification.

As noted above, claim 37 is now directed to a method for establishing a risk of developing a disorder associated with a substitution of cytosine (C) by thymine (T) at position 825 in SEQ ID NO: 1. Applicant respectfully submits that in order to practice the invention of claim 37, a skilled artisan simply has to check whether or not the disorder is associated with a substitution of cytosine by thymine at the position set forth in the claim. As is clear from the disclosure of the present application, a skilled artisan will expect a correlation between a substitution of cytosine by thymine at position 825 not only with hypertension, but with other disorders.

Accordingly, Applicant respectfully submits that claim 37 is enabled by the present specification and therefore the rejection should be withdrawn.

Claims 13, 14, 15, 18, 19, 32, 33 & 35 stand rejected under 35 U.S.C. §112, first paragraph.

Applicant respectfully submits that this rejection has been obviated by the cancellation of the claims and therefore should be withdrawn.

Claims 13 – 19, 21 – 28, 32 – 35 and 37 stand rejected under 35 U.S.C. §112, second paragraph.

Applicant respectfully submits that the amendments to the claims have obviated this rejection, which should therefore be withdrawn.

Claim 36 stands rejected under 35 U.S.C. §101, as claiming the same invention as that of claim 1 of prior U.S. Patent No. 6,242,181.

Applicant respectfully submits that the amendments to the claims have obviated this rejection which should therefore be withdrawn.

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Claims 13 – 19, 21 – 28, 32 – 35 and 37 stand rejected under the judicially created doctrine of obviousness – type double patenting as being unpatentable for claims 1 – 7 as of U.S. Patent No. 6,242,181.

As this is a provisional obviousness-type double patenting rejection, Applicants respectfully request that the Examiner hold the rejection in abeyance until such time as allowable subject matter is obtained.

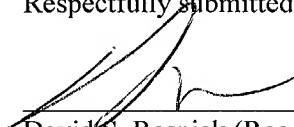
The Applicant believes that the present application, as amended, is in a condition for allowance and issuance of the Patent is earnestly solicited.

Applicant is submitting a Petition for 3-Month Extension and Fee. In the event that additional fees are associated with this matter the Commissioner is authorized to charge the NIXON PEABODY LLP Deposit Account No. 50-0850 for any such deficiencies.

Date: 2/10/03

Customer No.: 26770

Respectfully submitted,

  
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